

### **REMARKS**

Applicant has carefully reviewed the Office Action mailed on July 6, 2004. Applicant thanks the Examiner for accepting and recording the Terminal Disclaimer. Applicant also thanks the Examiner for the withdrawal of the prior 35 U.S.C. § 103(a) rejection based on Gambale et al.

As a preliminary matter, Applicant brings to the Examiner's attention that formal drawings were submitted on October 30, 2000, but there has been no indication of approval of the drawings by the Examiner or the Official Draftsman. Applicant requests that the Examiner/Official Draftsman indicate approval or non-approval of the formal drawings with the next PTO communication.

#### **Rejections Under 35 U.S.C. § 103(a)**

The Examiner rejected independent claims 37, 39, 41 and dependent claims 38, 40, 42 under 35 U.S.C. § 103(a) as unpatentable over Huter et al., U.S. Patent Number 6,139,511, in view of Doyle et al., U.S. Patent Number 5,007,434. Applicant respectfully traverses the Examiner's rejection of independent claims 37, 39, 41 and dependent claims 38, 40, 42 as unpatentable under 35 U.S.C. § 103(a) over Huter et al., in view of Doyle et al. Applicant asserts claims 37-42 are patentable over the cited references.

Huter et al. teach a guidewire core member with radiopaque markers to indicate where a tapered segment begins or ends (see column 2, lines 44-46). The length of the first tapered segment, and therefore the distance between the markers, is preferably from about 6 cm to 8 cm (see column 4, lines 53-56). The length of the second tapered segment is preferably 3.5 cm (see column 5, lines 4-5). The marker placement taught by Huter et al. allows a physician using the

guidewire to identify relative flexibility and stiffness. (See column 2, lines 46-49). Doyle et al. teach a radiopaque marker 7 to 8 cm from the distal tip, defining the start of a series of bends in the guidewire (see column 4, lines 32-36). The marker placement taught by Doyle et al. facilitates redirection of the catheter tip.

In contrast, Applicant's independent claims 37, 39 and 41 recite markers defining a plurality of 1.5 cm longitudinal spaces therebetween. The 1.5 cm spacing is advantageous over the cited art because it corresponds to the distance between the distal end of a balloon catheter and the midpoint of the balloon, where a marker band is placed. Further, by centering a guidewire marker over the stenosis and aligning the midpoint balloon marker, the center of a balloon will be aligned with the center of a stenosis, thus reducing contrast dye injections. Consequently, the patient and staff may be subject to less radiation exposure and the patient will have fewer complications from dye injections (see page 14 lines 14-18). Moreover, the plurality of guidewire markers spaced evenly apart 1.5 cm allows the physician to align one marker and use the adjacent markers to determine precisely how much of the stenosis will be contacted by the balloon member when it is inflated (see page 14, lines 4-6).

Neither of the cited reference guidewires nor their combination could be used for the improved alignment and monitoring functions addressed by Applicant's claimed invention. The placement of the markers taught by Huter et al. and Doyle et al. would not align properly with a balloon midpoint marker and the catheter tip, nor would they provide the consistent spacing needed to determine balloon coverage with respect to the stenosis. As stated by the Examiner, the cited references do not teach the dimensions of the longitudinal space between the markers. Therefore, it would not be obvious to one skilled in the art to combine the cited references since they do not teach the claimed invention.

Applicant asserts that independent claims 37, 39 and 41 distinguish over Huter et al. and Doyle et al. Because claims 38, 40 and 42 depend from claims 37, 39, and 41, which are distinguishable over Huter et al. and Doyle et al., Applicant asserts that claims 38, 40 and 42 also distinguish over Huter et al. and Doyle et al. and because they include further distinguishing elements.

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

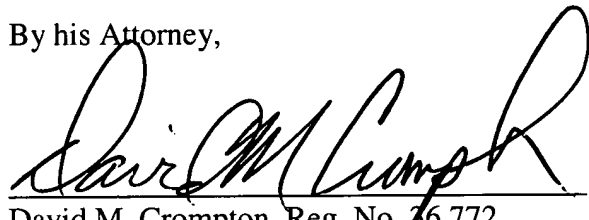
Respectfully submitted,

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By his Attorney,

Date: \_\_\_\_\_

10/6/04



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